

Applicant: Gardi et al.
Filed: June 29, 2001
Application No.: 09/893,597

REMARKS

The present Amendment and Response is responsive to the Office Action mailed January 18, 2007. As a preliminary matter, Applicants have amended Claims 1, 7-8, 13, and 19-20 and added new Claims 38-53. Claims 5, 9-11, 17, 21-23, 25, and 26-37 are cancelled. Therefore, Claims 1-4, 6-8, 12-16, 18-20, 24, and 38-53 are currently pending. Applicants respectfully submit that support for these amendments and additions can be found in the specification and that no new subject matter has been added by the afore-mentioned claim amendments or additions.

Furthermore, as a result of the Examiner's amendments renumbering the claims in the present application due to the previous omission of claim number 33, Applicants accordingly renumber the claims herein and refer to the claims as amended by the Examiner.

Accordingly, Applicants respectfully request reconsideration and allowance of the application.

Claim Rejections under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected Claims 1-4, 6, 13-16, and 18 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,196,458 to Walker et al. ("Walker"). Walker is directed to a billing system that uses pre-determined criteria, namely an account holder's purchase history on a billing statement, to provide upsell offers in the account holder's billing statement. More specifically, in Walker a central controller 12 receives possible upsell offers for each merchant from merchant terminals. (Walker, col. 3, ll. 33-62). After receiving the upsell offers, the central controller 12 determines what upsell offers to print on a billing statement based on account holder billing information. (Walker, col. 6, ll. 44-65). The Walker specification expressly discloses minor variations on the previously described process, such as the central controller 12 searching an account transaction database 27 for transactions that satisfy pre-determined criteria, or the central controller 12 searching an upsell database 30 for conditions that are satisfied by each account holder. (Walker, col. 7, ll. 22-30). Notwithstanding these

variations, each of the sources that the central controller 12 may query are databases stored within and operated by the central controller. (See Walker, col. 4, ll. 25-38 and Fig. 2).

Applicants amend Claim 1 to recite the step of “determining that the customer qualifies for presentment of a supplemental information item by transmitting a request to a customer relationship management system and receiving a response from the customer relationship management system including information indicating that the customer qualifies for presentment of the supplemental information item.” Additionally, the step of “generating a bill presentment” is amended to recite “generating a bill presentment including at least the received billing information and the supplemental information item.” This amendment further clarifies that a request is sent to and a response received from a customer relationship management (“CRM”) system to determine that a customer qualifies for presentment of supplemental information and that the bill presentment includes the supplemental information item. Applicants also eliminate “wherein” clauses made unnecessary by this amendment.

While Applicants have removed the clause “wherein the qualification information does not include financial factors associated with the received billing information, historical billing information, associated with the customer, or credit information associated with the customer” by the amendments to Claim 1 listed above, Applicants respectfully maintain their disagreement with the Examiner’s statement that describing what the qualification information does or does not include is a descriptive non functional element that carries no patentable weight. Applicants submit that no new matter is added by this amendment and that support can be found throughout the specification.

Applicants respectfully assert that Walker fails to teach or suggest each element of amended Claim 1. Walker does not disclose or suggest the step of transmitting a request to a customer relationship management (“CRM”) system to determine that the customer qualifies for presentment of the supplemental information item, as is stated in amended Claim 1. While the Examiner identifies the central controller 12 as satisfying this step of the method, as Applicants pointed out in the previous office action, the central controller 12 of Walker can not satisfy the same functionality. More specifically, Walker discloses only a central controller 12 and no other

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system element (i.e., CRM system) to which the central controller 12 may transmit a request. If, as the Examiner suggests, the central controller 12 is also a CRM system, then Walker fails to disclose a system element to transmit a request to the CRM system / central controller. Similarly, if the central controller is the element transmitting the request and receiving the responses, then Walker discloses no CRM system for receiving requests and transmitting responses. Additionally, the customer relationship management system of Applicants' invention is described in the specification, and known to those of skill in the art, as a database storing customer characteristics beyond that stored in billing or financial transaction systems. As described above, the system in Walker analyzes criteria based exclusively on billing transaction information – information clearly different than what would be maintained in CRM systems. For the same reasons, Walker additionally fails to teach the step of receiving a response from a customer relationship management system. Accordingly, Applicants assert that Walker fails to teach the step of transmitting a request to a customer relationship management system, and the step of receiving a response from the customer relationship management system, and thus does not anticipate Claim 1.

As to Claim 13, Applicants amend Claim 13 similar to that of Claim 1. Thus, Applicants submit that for at least the same reasons as described for Claim 1, Walker fails to recite every limitation of Claim 13.

As to Claim 6, Applicants submit that Walker does not disclose a CRM system maintained by the biller, and thus does not anticipate Claim 6. As discussed above, Applicants assert that Walker does not disclose a CRM system or its equivalent at all. However, assuming *arguendo* that a system element described in Walker may be interpreted as a CRM system, there is no teaching or suggestion of a system maintained by the biller performing the functions of the CRM system in Applicants' invention. More specifically, where the Examiner states that the central controller 12 of Walker suffices as the CRM system, Claim 6 requires the CRM system be maintained by an entity different than the entity receiving and presenting billing information (the central controller 12 in Walker). Accordingly, Applicants assert that Walker fails to anticipate Claim 6 for at least failing to disclose a CRM system maintained by the biller.

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Accordingly, Applicants assert that because Walker does not teach or suggest each and every limitation of Applicants' Claims 1 and 13, Claims 1 and 13 are patentable over Walker under 35 U.S.C. § 102(e), and in condition for allowance. Additionally, Applicants assert that Claims 2-4, 6, 14-16, and 18 are allowable as a matter of law as depending from allowable claims, notwithstanding their independent recitation of patentable features.

Claim Rejections under 35 U.S.C. § 103: Combination of Walker and Katz

In the Office Action, the Examiner rejected Claims 7, 19, and 26-37 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of U.S. Patent No. 6,055,513 to Katz et al. ("Katz").

As to Claims 26-31, Applicants cancel Claims 26-37 by this amendment without prejudice. Accordingly, Examiner's rejections to Claims 26-37 are made moot by this amendment.

As to Claims 7 and 19, Applicants respectfully reassert, as in the prior two responses, that there exists no motivation, teaching, or suggestion to combine Katz with Walker. However, assuming *arguendo* that combining Katz with Walker is proper, Applicants submit that the combination still fails to disclose every limitation of amended Claims 7 and 19. Applicants amend Claims 7 and 19, similar to Claims 1 and 13, respectively, to further clarify their scope, distinguish their patentable features, and improve readability. Furthermore, Applicants respectfully assert that Claims 7 and 19 depend from Claims 1 and 13, respectively, and are patentable as a matter of law as depending from patentable claims, notwithstanding their independent recitation of patentable features.

Claim Rejections under 35 U.S.C. § 103: Combination of Katz and Munsil

In the Office Action, the Examiner rejected Claims 8-12 and 20-24 under 35 U.S.C. § 103(a) as being unpatentable over Katz in view of U.S. Patent No. 5,761,650 to Munsil et al. ("Munsil").

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Katz is directed towards a telemarketing / electronic commerce system for the real-time offering of incentives or alternatives for purchases (e.g., an upsell) to a prospective customer at the time of a primary transaction with the prospective customer. (Katz, Abstract and col. 12, ll. 56-58). The primary transaction may be associated with a telephone or computer link contact for a sale, commercial transaction, service, or repair transaction (Katz, Abstract and col. 13, ll. 64-67). More specifically, in the telemarketing / electronic commerce system of Katz, the received order data of the primary transaction is compared with other data for analysis to determine “upsell” data to then offer to the customer. (Katz, col. 13, lines 60-64).

Munsil is directed towards a bill editor and generator that allows for messages and notices to be included as inserts with a billing statement (Munsil, Abstract). More specifically, the system of Munsil allows for identifying inserts and assigning priorities thereto. (Munsil, col. 12, ll. 25-39). The system then determines which inserts to include, based on either the available physical space on the billing statement (Munsil, col. 12, ll. 55-67) and/or the total weight of the mailing so as to reduce the postage costs (Munsil, col. 13, ll. 8-30), including higher priority inserts over lower priority inserts.

Applicants amend Claim 8 to further clarify the scope of the claim and improve its readability. More specifically, Claim 8 affirmatively recites the steps of “determining that the customer qualifies for presentment of a first supplemental information item having a first priority and a second supplemental information item having a second priority” and “determining that the first and the second supplemental information items are not allowed to be presented together.” Finally, Claim 8 recites “generating a bill presentation including at least the received billing information and one of the first and the second supplemental information items having the highest priority” and “presenting the generated bill presentation to the customer.” Applicants submit that the clarifications made by this amendment do not add new matter and find full support in the specification. Further, Applicants respectfully submit that these amendments further clarify the claims scope and distinguish the patentable features, and thus for at least these reasons and those presented below, Claim 8 is patentable over the references cited.

One aspect of the present invention, as recited in amended independent Claim 8, includes a method which determines that one supplemental information item are not allowed to be presented with a different supplemental information item. Therefore, only the supplemental information item having the higher priority of the two is presented. The method recited in Claim 8 includes the steps of determining that a customer qualifies for presentment of a first supplemental information item having a first priority and a second supplemental information item having a second priority. The method further includes the step of determining that the first and second supplemental information items are not allowed to be presented together. Finally, because a customer qualifies for two supplemental information items but those two items are not allowed to be presented together, the item having the highest priority will be presented with the generated bill.

The Examiner stated in his reasons for rejecting Claims 8-12 that Katz discloses the step of determining if the first and second supplemental information items can be presented together. However, the Examiner failed to provide specific support of how Katz discloses this step. Additionally, Applicants amend Claim 8 to further clarify the scope and improve the readability of the claim, as discussed below. Applicants respectfully contend that Katz does not teach or suggest the step of determining that two supplemental items are not allowed to be presented together. Furthermore, Munsil makes no determination that two supplemental information items are not allowed to be presented together. Although Munsil does disclose prioritizing the inserts, the prioritizations only occur when space is limited on a billing statement or to limit the weight of the mailing so as to limit postage costs. (Munsil, col. 12, ll. 55-67 and col. 13, ll. 8-30). In contrast, Claim 8 determines when one supplemental information item is not allowed to be presented with another. For example, the biller may wish that the customer's attention from a certain supplemental information item not be diverted by another supplemental information item, and thus not allow co-presentment. (Applicants' Specification, p. 20, ll. 23-25). Therefore, Applicants assert that neither Katz nor Munsil nor a combination thereof teach or suggest the step of determining that the first and second supplemental items are not allowed to be presented together.

As to Claims 20-24, Applicants respectfully assert that for at least the same reasons as for Claims 8-12, Claims 20-24 are patentable over Katz, Munsil, and any combination thereof. More specifically, neither Katz nor Munsil teach or suggest a system that is configured to determine that a first and a second supplemental information item are not allowed to be presented together as recited in amended independent Claim 20. Thus, amended Claim 20 and Claims 21-24 depending therefrom are patentable over Katz, Munsil, and any combination thereof. Applicants also amend Claim 20 similar to Claim 8 and for at least the same reasons as described above.

Accordingly, Applicants respectfully assert that neither Katz, Munsil, nor a combination thereof, teach or suggest the step of (or a system configured for) determining that the first and second supplemental items are not allowed to be presented together, and therefore Claims 8 and 20 are allowable over Katz, Munsil, and any combination thereof and both claims are in condition for allowance. Additionally, Applicants assert that Claims 9-12 and 21-24 are allowable as a matter of law as depending from allowable claims, notwithstanding their independent recitation of patentable features.

New Claims Allowable Over the Prior Art of Record

Applicants submit new independent Claim 38, which includes the steps of first “transmitting a request that includes qualification information associated with at least one supplemental information item to a customer relationship management system; receiving a response to the request that identifies at least one customer that qualifies for presentment of the at least one supplemental information item based on the qualification information;” then, “subsequent to receiving the response, receiving billing information for the at least one customer; generating a bill presentation for the at least one customer including at least the received billing information at least one the supplemental information item; and presenting the generated bill presentation to the at least one customer.” Applicants submit that no new matter is added by this amendment and that support can be found at least in reference to FIG. 3A and the text accompanying it.

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Furthermore, Applicants respectfully assert that the prior art as cited herein and by the Examiner does not teach steps where at least one customer is identified as qualifying for a supplemental information item independently and before the steps of bill generation and bill presentment are carried out. For example, the system of Walker determines if a customer should be presented an upsell based on information from a billing statement, thus only after receiving the billing statement. (*See* Walker, Abstract and FIG. 6 and accompanying text). Similarly, the system of Katz utilizes information about a customer gathered during a primary transaction in which the customer contacts the service provider to identify possible upsells to offer to that customer during the transaction. (*See* Katz, Abstract and FIGS. 1, 4, and 7 and accompanying text). Munsil also requires considering criteria as to which inserts to include in a billing statement after the billing statements have been run (e.g., during the bill run segment 1520 of FIG. 7) because the determinations are specific to size and/or weight of each bill. (*See* Munsil, FIG. 7 and accompanying text). Accordingly, Applicants submit that newly submitted independent Claim 38 is allowable over the references cited by the Examiner because the steps of first identifying customers that qualify for the supplemental information item and then beginning bill generation and presentment are not disclosed by the references cited. Furthermore, Applicants respectfully assert that Claims 39-42 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Applicants also add new independent Claim 43, which recites a system having limitations similar to the above-discussed Claim 38. Accordingly, for at least the same reasons as provided for Claim 38 above, Applicants respectfully submit that Claim 43 is allowable over the references cited. Furthermore, Applicants respectfully assert that Claims 44-47 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Finally, Applicants add new Claims 48-50, depending from Claim 8. These claims are added to include claim steps that were eliminated from Claim 8 by this amendment as discussed above and to include further dependencies similar to those depending from Claim 1. Similarly, Applicants add new Claims 51-53, depending from Claim 20 to include claim elements that were

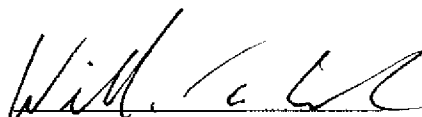
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eliminated from Claim 20 by this amendment as discussed above and to include further dependencies similar to those depending from Claim 13. Accordingly, Applicants respectfully assert that Claims 48-53 are allowable as a matter of law as depending from allowable claims, notwithstanding their independent recitation of patentable features.

CONCLUSION

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,


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